

No. 14399.

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

D & H ELECTRIC COMPANY, a corporation,

Appellant,

vs.

M. STEPHENS MFG., INC., a corporation, and JACK Mc-
LOUGHLIN, doing business as McLoughlin Sales,

Appellees.

APPELLEE'S BRIEF.

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APPELLEE'S BRIEF.

I.

STATEMENT OF JURISDICTION.

Appellee concedes that both the District Court and the Court of Appeals have jurisdiction of this case. We hereby adopt, as our own, Appellant's statement of jurisdiction.

II.

QUESTION PRESENTED.

The question presented to this court is simply whether or not the trial court's Findings of Fact are "clearly erroneous" within the meaning of Rule 52(a), Federal Rules of Civil Procedure.

III.

SUMMARY OF ARGUMENT.

Appellee respectfully submits that far from being “clearly erroneous,” the Findings of the trial court are the only ones consistent with the evidence. The record discloses that the accused device achieves an old result by a *means* and an *operation* different from that taught in the patent in suit. The patent teaches the disposition of ribs at “substantially right angles” to the axis of the sleeve. The accused device, on the other hand, contains interrupted threads which are disposed at varying degrees from the right angle ranging from 1° in the smallest coupler to 5° in the largest coupler.

This choice of a different *means* results in an entirely different *operation* or function. The patent describes a jamming or cross-threading operation which has the effect of stretching the conduit lengthwise or axially. [R. pp. 47, 68, 113.] The accused device operates by the simple expedient of inserting a larger object into a smaller one, thus causing an *outward* pressure on the inside of the conduit. [R. pp. 113-114, 122.] In other words, the patented method of operation—the cross-threading or jamming—is not utilized by Appellee’s device. The physical evidence demonstrates that the difference of one to five degrees has the effect of making the accused device “fit” the flex, whereas the whole purpose of the limited patent granted Appellant is to cause the connector to “misfit” the flex.

IV.
ARGUMENT.

A. Unless "Clearly Erroneous," the Trial Court's Findings Will Not Be Disturbed on Appeal.

Findings of patentability, infringement and equivalence, or the absence thereof, are determinations of fact which will not be upset on appeal unless they are "clearly erroneous."

Fed. Rules of Civ. Proc., Rule 52(a);

Graver Tank and Mfg. Co. v. Linde Air Products,
339 U. S. 605, 609-611, 70 S. Ct. 854, 94 L. Ed.
1097;

Jacuzzi v. Berkeley Pump Co., 191 F. 2d 632, 634
(C. A. 9, 1951);

Patterson-Ballagh Corp. v. Moss, 201 F. 2d 403
(C. A. 9, 1953);

Leishman v. General Motors, 191 F. 2d 522 (C. A.
9, 1951), *cert. den.* 342 U. S. 943.

The Supreme Court in the *Graver Tank* case stated at page 609:

"A finding of equivalence is a determination of fact * * *. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous. Particularly is this so in a field where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience."

The Court of Appeals for the Seventh Circuit discussed the *Graver Tank* case and then remarked:

“Thus, there is no room longer to doubt that the issues most prevalent in patent litigation, and particularly those of validity or invalidity, infringement or non-infringement, are issues of fact and that a finding by the trial court on such issues is within the terms of Rule 52(a) * * *.”

Hazeltine Research v. Admiral Corp., 183 F. 2d 953, 955.

The *Hazeltine* case was cited with approval by this court in *Leishman v. General Motors*, 191 F. 2d 522.

B. The Evidence Supports the Court's Finding That Appellant's Coupler Is Not "Equivalent" to the Teaching of the Patent in Suit.

To be "equivalent" the accused device must perform substantially the same function in substantially the same way to obtain the same result.

Patterson-Ballagh Corp. v. Moss, 201 F. 2d 403 (C. A. 9, 1953).

The range of equivalents depends upon the degree of invention, and if the patent is for a slight improvement on an old device, the range of equivalents is very narrow. The range of equivalents cannot be extended to cover means which have clear antecedents in the prior art.

Ganter v. Unit Venetian Blind, 89 Fed. Supp. 479 (D. C. Calif., 1950).

If one of the elements of the claim is omitted in the accused device, there is no infringement.

Simons v. Davidson, 106 F. 2d 518 (C. C. A. 9, 1939);

Edwards v. Hychex, 171 F. 2d 259 (C. C. A. 7, 1948).

1. The "Means" Used Is Different.

Appellant's own evidence demonstrates that the D & H coupling and patent require ribs that describe an angle of ninety degrees to the longitudinal axis of the coupling, whereas Appellee's device contains protuberances that vary from one to five degrees off the right angle. Appellant's expert witness, Mr. Berry, testified that the ribs on the D & H coupling extend *perpendicular* to the longitudinal axis. [R. p. 83.] This same witness introduced Plaintiff's Exhibits 26, 27 and 28, which reveal that Appellee's couplers vary 3.5° , 2° and 5° respectively, from the perpendicular. [R. p. 90.] Appellant's witness Horton later testified that the smallest coupling manufactured by Appellee formed a right angle to the axis of the sleeve. But after the court pointed out to the witness that he could clearly see the angle, Appellant's Counsel measured the device and found it to be one degree. [R. pp. 140-141.] Appellee's witness Friedman testified that the ribs on his device are about $3\frac{1}{2}$ degrees off the right angle.

But appellant maintains that since the single claim allowed by the Patent Office uses the phrase "substantially at right angles," there is infringement. The trial judge found that the word "substantially," as used in the claim, "* * *" is intended to take care of such tolerances as may be allowed in the construction of devices which are not in the realm of precision devices and the construction of precision instruments." [R. p. 181, see also p. 100.] The evidence and all reasonable inferences therefrom supports this conclusion.

In *Moss v. Patterson-Ballagh Corp.*, 89 Fed. Supp. 619, 627 (D. C., S. D. Cal.), *aff'd* 201 F. 2d 403 (C. A. 9, 1953), Judge Weinberger stated:

“The word ‘substantially’ is a relative term and should be interpreted in accordance with the context of the claim in which it is used.”

2. Patent Limited to RIGHT ANGLE.

This court in *Schnitzer v. California Corrugated Culvert Co.*, 140 F. 2d 275, 276, held:

“Where the claim uses broader language than the specifications, reference may be had to the latter for the purpose of limiting the claim * * *.

“The file wrapper contains evidence that the inventor understood this element of his claim in the narrower sense. * * * the proceedings [before the Patent Office] may be used to aid in construing the claim, * * *.”

With this background, let us examine the Record.

First, we find the following in the specifications of the patent itself:

“Disposed on the outer surface of the sleeve, 1 is a series of protuberances 3, 4, 5 and 6, in the form of ribs extending for short distances on the sleeve in a direction *at right angles* to the axis of the sleeve. * * *” (Emphasis supplied.) [Pltf. Ex. 1, Col. 2, line 37, *et seq.*]

Thus, under the rule laid down in *Schnitzer*, it becomes quite apparent that “substantially” has the meaning attributed to it by the trial judge.

Second, the file wrapper [Def’t. Ex. D], discloses that the patentee understood his invention to consist of the disposition of ribs *at right angles*—not interrupted screw

threads *at angles*. In a letter to the Patent Office, Appellant's Patent Counsel and expert witness, Mr. Berry, wrote as follows:

"The other references show interrupted screw threads and do not teach applicant's arrangement of ribs which are extended *at right angles* to the axis of the coupling. In other words, applicant's ribs cannot be likened to screw threads as they perform an entirely different function entirely beyond the concept of any of the references.

"Reconsideration of claims 10, 11, 14 and 16 is respectfully requested inasmuch as each of these claims define the novel ribs extending *at right angles* to the axis of the sleeve a distance less than one-half of the circumference of the sleeve. This feature is not shown nor suggested by any of the references. As pointed out the secondary references merely show interrupted screw threads and applicant's ribs cannot be likened to such screw threads." (Emphasis supplied.)

With this letter, Mr. Berry proposed the change in the wording of the claim which contains the phrase "substantially at right angles." It is, therefore, quite obvious that the use of the word "substantially" was not intended to tolerate variations of from one to five degrees off the horizontal.

Third, the patentee elected to prosecute claims drawn to the invention as shown in Figure 2 [Def't. Ex. D]. Figure 2 shows the ribs to be at right angles [Pl'tf. Ex. 1].

Fourth, the prior art, and the correspondence from the Patent Office demonstrates that the claim was allowed because of the right angle ribs, and for no other reason. The Wilson Patent, No. 1,629,058 [Def't. Ex. C], reveals that ribs, or interrupted threads which are a few de-

grees off the perpendicular are old in the art. [Ribbs 18 in Figure 2.]

Fifth, in the manufacture of an article of this sort, one generally expects some variation, since it is not a precision instrument. Hence, the word “substantially” is used to cover such minor deviations. This is somewhat illustrated by the testimony of Appellant’s expert witness, Mr. Berry, who used the word “materially” to describe variations greater than the thickness of a pencil line. The witness stated that his calculations “* * * might fluctuate perhaps the thickness of a pencil line, but not *materially*.” [R. pp. 84-85.]

Sixth, if the patent were construed to include the type of device manufactured by Appellee, then it would be clearly invalid, as having been anticipated by the prior art [see especially figure 2 of Wilson, 1,629,058, Deft. Ex. C]. The opinion of the trial court clearly demonstrates that the patent was held valid *only* because of the narrow construction which limits the range of equivalents to those devices whose ribs or protuberances are, to all intents and purposes, at right angles. The patent would be invalid if construed to cover Appellee’s device.

On page 13 of his brief, Appellant’s Counsel quotes from an opinion by Judge Learned Hand in *Musher Foundation v. Alba Trading Co.*, 150 F. 2d 885, 889. There, the learned Judge remarks that the word “substantially” adds nothing to a patent claim, but merely expressly states that which is always implied, namely, that slight variations *that do not lose the benefit of the invention*, may constitute infringement. The benefit, if any, of Appellant’s invention is the locking by jamming or cross-threading. We will see presently that this benefit is entirely lost by changing the angle of the protuberance.

3. The "Operation" Is Different.

The evidence amply supports the trial court's finding that the accused device does not operate on the patented principle. The object of the invention is to connect flexible conduit to an electrical junction box by jamming or cross-threading, thus stretching the conduit axially. [Patent in suit, Pltf. Ex. 1, Col. 1, lines 18-31; R. pp. 47, 68, 113.] The accused device does not jam, cross-thread or stretch the conduit axially. To the contrary, Appellee's couplers exert an outward pressure, thus causing a "tight fit." [R. pp. 113-114, 122.] Appellee's operation merely follows the Hunter patent, No. 1,775,128. [Deft. Ex. C; R. p. 154.]

Appellant offered no evidence on this issue. Their expert witness, Mr. Berry, testified that he had conducted no experiments to determine what happens to the ribs on the inside of the conduit. [R. p. 101.] Fortunately, however, the couplers are made of zinc, a softer metal than the steel conduit, and scratches on the ribs of the couplers demonstrate the difference in the operation of the two couplers. [R. pp. 112-113, 79-80.] Plaintiff's Exhibit 3, the patented coupling, shows abrasions on the ends of the two ribs indicating the places where they have been jammed into the flex. Plaintiff's Exhibit 18, one of the accused devices, shows abrasive markings all along the upper surface of the ribs, where they have exerted *outward* pressure. [R. pp. 79-80.]

4. The "Result" Is Old.

The result achieved by the patent in suit is no different from that revealed in the prior art. Appellant attempted to show that its device made a tighter fit than the prior devices, but the demonstration of the Jake device per-

formed by witness Friedman, reveals that it accomplishes the same result as does the patent in suit. [R. pp. 117-118.] Appellant also attempted to show infringement by demonstrating that neither its coupler nor appellee's coupler could be removed from the flex without the aid of pliers. However, later in the trial, Mr. Horton removed one of the accused couplers from a newly purchased article, and found that the coupler came out of the flex quite easily by hand operation. [R. p. 142.]

V.

CONCLUSION.

Appellee respectfully submits that the evidence fully supports the trial court's Findings; that the plaintiff failed to sustain its burden of proof on the question of infringement; that the Findings of the trial court are not "clearly erroneous"; and that the patent is invalid if construed to cover Appellee's device.

Respectfully submitted,

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